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| FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413 | | | BORISOV, IGOR N | |
| | | ART UNIT | PAPER NUMBER | |
| | | | 3639 | |

DATE MAILED: 10/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/024,622 | GIACCHETTI ET AL. | |
| | Examiner | Art Unit | |
| | Igor Borissov | 3639 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 11 July 2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-25 and 27-61 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-25 and 27-61 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Amendment received on 7/11/2006 is acknowledged and entered. Claims 1, 5, 32, 39, 44, 49 have been amended. Claims 1-25 and 27-61 are currently pending in the application.

Claim Rejections - 35 USC § 112, first paragraph,

Claim Rejections under 35 USC § 112, first paragraph, have been withdrawn due to the applicant amendment.

Claims 31 and 49 are rejected under 35 U.S.C. 112,

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-25 and 27-61 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent Claims 1, 5, 31, 32, 39, 44, 45, 46, 48, 49 and 50 employ one or more of the following terms: "facilitating", "enabling", "encouraging", "prescribing", "associating", "instructing" and "causing", which are vague and indefinite. Claim 1 recites: "facilitating storage of information". The Claim does not recite actual "storing" step. Therefore, the examiner does not understand how said "facilitating storage of information" step differs from "storing" step.

The specification does not provide adequate explanation of said terms. For example, paragraph [089] on page 32 of the specification gives following vague and mutually exclusive definitions of said terms:

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"enabling", "facilitating", and "causing" an action refer to one or more of a direct act of performing the action, and any indirect act of encouraging or being an accessory to the action. Thus, the terms include partnering or cooperating with an entity who performs the action and/or referring commerce to or having commerce referred from an entity who performs the action. Other examples of indirect activity encompassed within the definitions of "enabling" "facilitating" and "causing" may include providing a subject with one or more of tools to knowingly aid in performing the action, providing instructions on how to perform the action, providing prompts or cues to perform the action, or expressly encouraging performance of the action. Indirect activity may also include cooperating with an entity who either directly performs the action or who helps another perform the action. Tools may include software, hardware, or access (either directly, through hyperlink, or some other type of cooperation or partnering) to a network location (e.g., web site) providing tools to aid in performing the action. Thus, phrases such as "enabling access" and "enabling display" do not necessarily require that the actor actually access or display anything."

Accordingly, the specification explains that the step of "enabling display" does not require displaying anything! At this point Examiner maintains that he does not understand what the term enabling means.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-25 and 27-61 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In determining whether the claimed subject matter is statutory under 35 U.S.C. 101, a practical application test should be conducted to determine whether a "useful, concrete and tangible result" is accomplished. See *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1359-60, 50 USPQ2d 1447, 1452-53 (Fed. Cir. 1999); *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368, 1373, 47 USPQ2d 1596, 1600 (Fed. Cir. 1998).

An invention, which is eligible or patenting under 35 U.S.C. 101, is in the "useful arts" when it is a machine, manufacture, process or composition of matter, which produces a concrete, tangible, and useful result. The fundamental test for patent eligibility is thus to determine whether the claimed invention produces a "useful, concrete and tangible result". The test for practical application as applied by the examiner involves the determination of the following factors"

(a) "**Useful**" – The Supreme Court in *Diamond v. Diehr* requires that the examiner look at the claimed invention as a whole and compare any asserted utility with the claimed invention to determine whether the asserted utility is accomplished.

Applying utility case law the examiner will note that:

- i. the utility need not be expressly recited in the claims, rather it may be inferred.
- ii. if the utility is not asserted in the written description, then it must be well established.

(b) "**Tangible**" – Applying *In re Warmerdam*, 33 F.3d 1354, 31 USPQ2d 1754 (Fed. Cir. 1994), the examiner will determine whether there is simply a mathematical construct claimed, such as a disembodied data structure and method of making it. If so, the claim involves no more than a manipulation of an abstract idea and therefore, is nonstatutory under 35 U.S.C. 101. In *Warmerdam* the abstract idea of a data structure became capable of producing a useful result when it was fixed in a tangible medium, which enabled its functionality to be realized.

(c) "**Concrete**" – Another consideration is whether the invention produces a "concrete" result. Usually, this question arises when a result cannot be assured. An appropriate rejection under 35 U.S.C. 101 should be accompanied by a lack of enablement rejection, because the invention cannot operate as intended without undue experimentation.

The method steps recited in the Claims are expressed in the following terms: "facilitating", "enabling", "encouraging", "prescribing", "associating", "instructing" and "causing", which are vague and indefinite. For example, in Claim 1, the step of "facilitating storage of information" does not recite an actual "storing" step; the method

step “enabling display” or “enabling the subject to view the first information” does not require displaying anything and, therefore, does not provide *tangible* result. In Claim 31, the step of “prescribing a cosmetic product” and “providing the subject with viewing access to the subject record” does not indicate real world application, therefore does not provide *tangible* result. In Claim 32, the method steps of “instructing the beauty facility to capture images” and “instructing the beauty facility to display ...images” does not recite an actual “capturing” or “displaying” steps, therefore, does not provide neither *useful*, no *tangible* result. And so as “facilitating storage of information” does not require the “storing” step per se, the recited method steps as a whole do not provide the repeatable result either.

Accordingly, the claimed invention does not appear to provide tangible and/or useful and/or concrete result and, therefore, deemed to be non-statutory.

Same reasoning applied to the remaining Claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 31-38, 49, 57, 60 and 61 are rejected under 35 U.S.C. 102(e) as being anticipated by Hawkins et al. (US 2002/0054714).

Hawkins teaches a method and system for evaluating cosmetic product on a consumer, comprising:

Independent Claim

Claim 31. Selecting (prescribing) a cosmetic product for trial on the consumer's body [0038]; capturing an image of a body feature (*establishing a subject record*) [0039]; capturing a further image of the body feature at a later time after a cosmetic product has been applied by the consumer (*associating the at least one second image with the subject record*) [0041], wherein said capturing occurs at a sales counter (*beauty facility*) [0053]; digitally transforming the captured images to demonstrate effects of use of the cosmetic product (*associating the at least one second image with the subject record*; wherein the use of a computer inherently indicates *storing of the transformed information*) [0044]; displaying captured and transformed images to the user [0044].

Claim 32. Selecting a cosmetic product and capturing an image of a body feature before and after application of the cosmetic product at a sales counter (*beauty facility*) [0039]; [0053]; and displaying captured and transformed images to the user [0044]. Selecting the cosmetic product at the sales counter (*beauty facility*) inherently indicates *distributing* said cosmetic product to the point of sale. Examiner points out that without distributing said cosmetic product to said sales counter prior to offering said cosmetic product to the subject, it would not be possible to select and apply said product to the subject at said sales counter. Therefore, the step of "*distributing* said cosmetic product to the point of sale" is inherently disclosed in Hawkins. Furthermore, Hawkins teaches that the subject is assisted with said method at said sales counter by an operator [0053]. Examiner stipulates that without instructing said operator how to conduct said method prior to said "assisting" the subject, said operator would not be able to conduct said method. Therefore, the "instructing" steps are disclosed in Hawkins.

Claim 49. Selecting a cosmetic product for trial on the consumer's body (providing information) [0038]; capturing an image of a body feature [0039]; capturing a further image of the body feature at a later time [0041]; digitally transforming the captured images to determine differences that occurred in a body condition [0044]; offering (prescribing) a cosmetic product based on the results [0053]. Furthermore, Hawkins teaches that said method is a computer-implemented method [0053], thereby

inherently indicating providing a computer-readable medium having instruction to conduct said method steps.

Dependent Claims

Claim 33. Capturing images at the beauty facility [0053] inherently indicates providing “know-how” for said capturing to the beauty facility. Same reasoning as applied to **Claim 32.**

Claims 34-36. Providing a kit for displaying a consumer’s skin images, including a camera and a programmable device [0026], inherently indicates providing necessary software (drivers) for the system to operate.

Claim 37. Same reasoning as applied to **claim 34.**

Claim 38. A cosmetic product is selected for a trial for a consumer before each image is recorded [0013]; [0014].

Claim 54. Displaying to the subject side by side an original image and a digitally transformed image of the subject’s face to demonstrate effects (effectiveness) of a cosmetic product treatment [0044].

Claim 57. Same reasoning applied to claim 49.

Claim 60. Same reasoning applied to claim 49.

Claim 61. See reasoning applied to claim 56.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-24, 27-30, 48 and 50-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hawkins et al. (US 2002/0054714) in view of Marapane et al. (WO 01/87245).

Hawkins teaches a method and system for evaluating cosmetic product on a consumer, comprising:

Independent Claims

Claim 1. Capturing an image of a body feature [0039]; capturing a further image of the body feature at a later time after a cosmetic product has been applied by the consumer [0041]; digitally transforming the captured images to demonstrate effects of use of the cosmetic product (using a computer inherently indicates *storing* of the transformed information) [0044]; displaying captured and transformed images to the user [0044].

Hawkins does not specifically teach storing information reflecting the subject's usage of the beauty product.

Marapane et al. (Marapane) teaches a method and system for recommending beauty products (hair color agents), said method including obtaining information regarding how often a subject has colored his/her hair over the past year (Figs. 1 and 16, item 130; page 4, lines 16-17).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Hawkins to include storing information reflecting the subject's usage of the beauty product, as disclosed in Marapane, and, accordingly, displaying captured information to the subject, because it would advantageously allow to estimate subject's body (hair or skin) condition and ability to receive another coloring, thereby provide the subject with most suitable product (Marapane; page 4, lines 17-18).

Claims 5 and 48. Hawkins teaches: providing information about beauty products (selecting a cosmetic product for trial on the consumer's body) [0038]; capturing an image of a body feature [0039]; encouraging the subject to use at least one beauty product [0053]; capturing a further image of the body feature at a later time after a

cosmetic product has been applied by the consumer [0041], wherein said capturing occurs at a sales counter (*beauty facility*) [0053]; digitally transforming the captured images to demonstrate effects of use of the cosmetic product (using a computer inherently indicates *storing of the transformed information*) [0044]; displaying captured and transformed images to the subject [0044].

Hawkins does not specifically teach storing information reflecting the subject's usage of the beauty product, the usage occurring on at least one occasion between capture of the first image and capture of the second image.

Marapane et al. (Marapane) teaches a method and system for recommending beauty products (hair color agents), said method including taking initial color reading of the subject' hair; applying a beauty product to the subject's hair (coloring step); taking a second color reading of the subject' hear after said coloring step (page 8, lines 8-10).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Hawkins to include storing information reflecting the subject's usage of the beauty product, wherein the usage occurring on at least one occasion between capture of the first image and capture of the second image as disclosed in Marapane, and, accordingly, displaying captured information to the subject, because it would advantageously allow to estimate subject's body (hair or skin) condition and ability to receive another coloring, thereby provide the subject with most suitable product (Marapane; page 4, lines 17-18).

Claim 50. Selecting a cosmetic product for trial on the consumer's body [0038]; capturing an image of a body feature [0039]; capturing a further image of the body feature at a later time [0041]; digitally transforming the captured images to determine differences that occurred in a body condition [0044]; offering a cosmetic product based on the results [0053]; wherein the method steps can be conducted at the subject's home over the Internet [0053], thereby indicating:

providing a computer-readable medium having instruction embedded therein for conducting said method; and

enabling subject to control the saved data.

Hawkins does not specifically teach providing instructions for storing information reflecting subject's behavior between capture of the first image and capture of the second image.

Marapane et al. (Marapane) teaches a method and system for recommending beauty products (hair color agents), said method including taking initial color reading of the subject' hair; applying a beauty product to the subject's hair (behavior step); taking a second color reading of the subject' hear after said coloring step (page 8, lines 8-10).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Hawkins to include providing instructions for storing information reflecting subject's behavior between capture of the first image and capture of the second image, as disclosed in Marapane, and, accordingly, displaying captured information to the subject, because it would advantageously allow to estimate subject's body (hair or skin) condition and ability to receive another coloring, thereby provide the subject with most suitable product (Marapane; page 4, lines 17-18).

Dependent Claims.

Claims 2-3. Same reasoning as applied to **claim 1.**

Claim 4. Said method and system, wherein obtaining information occurs over the Internet [0053].

Claims 6-9. Said method and system, wherein a cosmetic product is offered at the point-of-sale [0053].

Claim 10. Said method and system, wherein enabling electronic capturing of at least one of the first and second first images includes providing the beauty facility with an image capture device [0053].

Claim 11. Said method and system, wherein access to the image capture device is provided over the Internet [0053].

Claim 12. Said method and system, wherein the external body condition is a skin condition of the subject's face [0046].

Claims 13-14. Same reasoning as applied to **claim 32.**

Claim 15. Same reasoning as applied to **claim 5.**

Claim 16. Same reasoning as applied to **claim 5**.

Claim 17. Same reasoning as applied to **claim 5**.

Claim 18. Displaying original and transformed images side-by-side to the consumer so that the consumer forced to pick one image [0044].

Claims 19-20. Providing a kit for displaying a consumer's skin images, said kit including a camera and a programmable device [0026], thereby inherently indicating providing necessary software (*drivers*) for the system to operate.

Claims 21-22. Same reasoning as applied to **claim 5**.

Claim 23. Said method and system, wherein said cosmetic product is offered to the consumer at a retail terminal [0053]. Information as to *is the retailer a manufacturer, reseller or wholesaler* is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See: *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembicza* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999). The recited method steps would be performed the same regardless whether the distributor is a manufacturer, reseller or wholesaler.

Claim 24. Displaying a consumer's skin images on a computer monitor [0026] indicates use of a *tangible recording media*.

Claim 27. Communications via the Internet indicates viewing said images at locations remote from the beauty facility [0053].

Claim 28. Hawkins teaches that capturing of the consumer's first and second images may be provided either in the beauty facility, or user's home (*location remote from the beauty facility*), and that the communication between the beauty facility and the consumer may be conducted over the Internet [0053].

Hawkins and Marapane does not specifically teach that after the *first* image is taken in the beauty facility, the consumer *is recommended* to capture the *second* image at the *location remote from the beauty facility*.

However, Hawkins does teach that said method can be conducted from consumer' home using a digital camera and the Internet [0053].

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Hawkins to include *recommending* the consumer to take the second image at home, because it would be convenient for the consumer to take the second image at the time suitable for the consumer.

Claim 29. Same reasoning as applied to claim 5.

Claim 30. Same reasoning as applied to claim 27.

Claim 51. Hawkins teaches that the consumer is enabled to maintain control through the use of software that stores the record at a location with access controlled by the consumer (conducting said method using consumer's digital camera at home and over the Internet) [0053].

Claim 52. Hawkins teaches said method and system, wherein the location is a portable information storage medium (the use of a computer at consumer's home indicates the use of the portable information storage medium) [0053].

Claim 53. Hawkins teaches displaying to the subject a digitally transformed image of the subject's face to demonstrate effects (effectiveness) of a cosmetic product treatment [0044].

Claims 54-56. Same reasoning as applied to Claim 5.

Claims 45-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maloney et al. (WO 01/18674 A2) in view of Marapane et al. (WO 01/87245).

Independent Claims

Claim 45. Maloney et al. (hereinafter Maloney) teaches a method and system for providing a customized product combination to a consumer, comprising: providing by the consumer information regarding preferred colors and styles, desired look of hair, desired look of face, level of involvement and lifestyle (page 7, lines 1-2); obtaining feedback from the consumer (*update*) for the cosmetic products offered (page 12, lines 15-16); based on the collected and updated information recommending a cosmetic product to the consumer (page 12, lines 15-16).

Maloney does not explicitly teach that said provided by the consumer information regarding preferred colors and styles, desired look of hair, desired look of face, level of involvement includes customer cosmetic product usage.

Marapane teaches a method and system for recommending beauty products (hair color agents), said method including obtaining information regarding how often a subject has colored his/her hair over the past year (Figs. 1 and 16, item 130; page 4, lines 16-17).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Maloney to include storing information reflecting the subject's usage of the beauty product, as disclosed in Marapane, and, accordingly, displaying captured information to the subject, because it would advantageously allow to estimate subject's body (hair or skin) condition and ability to receive another coloring, thereby provide the subject with most suitable product (Marapane; page 4, lines 17-18).

Claim 46.

Maloney teaches said method and system for providing a customized cosmetic product combination to a consumer, comprising: providing (recording) by the subject information regarding preferred colors and styles, desired look of hair, desired look of face, level of involvement and lifestyle over the Internet (page 7, lines 1-2); comparing the recorded information with a database of the same type of information of a plurality of individuals (page 7, lines 1-2, 9-11); determining whether the information provided by the subject is consistent with the same type of information of a plurality of individuals (page 7, lines 3-11; page 9, lines 21-22); recommending a cosmetic product to the subject based on said determination (page 7, lines 13-14).

Maloney does not explicitly teach that said provided by the consumer information regarding preferred colors and styles, desired look of hair, desired look of face, level of involvement includes customer cosmetic product usage.

Marapane teaches a method and system for recommending beauty products (hair color agents), said method including obtaining information regarding how often a

subject has colored his/her hair over the past year (Figs. 1 and 16, item 130; page 4, lines 16-17).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Maloney to include storing information reflecting the subject's usage of the beauty product, as disclosed in Marapane, and, accordingly, displaying captured information to the subject, because it would advantageously allow to estimate subject's body (hair or skin) condition and ability to receive another coloring, thereby provide the subject with most suitable product (Marapane; page 4, lines 17-18).

Dependent Claim.

Claim 47. Enabling the subject to record personal information about the subject's physical characteristics, and wherein the caused at least one product recommendation is a function of the subject's lifestyle and physical information (Maloney; lines 1-2).

Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hawkins in view of Marapane et al. and further in view of AS/400 Redbook Softcopy Library, an image of a CD (Document).

Dependent Claim

Claim 25. Hawkins teaches: displaying a consumer's skin images on a computer monitor [0026], thereby inherently indicating use of a *tangible recording media*.

However, Hawkins and Marapane does not teach that said tangible recording media includes a *visible marking* identifying a distributor.

Document discloses an image of a CD (which appears to be released in June, 1995), containing a *visual depiction* of a manufacturer/distributor (IBM).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Hawkins and Marapane to include that said tangible recording media includes a *visible marking* identifying a distributor, because it would advantageously promote distributor's products.

Claims 39-44 and 58-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maloney.

Independent Claims

Claim 39. Maloney teaches: providing a subject with a image capturing device for recording and displaying personal beauty information including an image of a subject (page 20, lines 27-28; page 26, claim 20); wherein said recording and displaying indicates recording said information on a computer-readable media. Furthermore, Maloney teaches that said recorded information could be read at beauty facilities (a central location or kiosks) and updated (page 11, line 17-18; page 15, lines 4-6). Providing the subject with image capturing device at home indicates updating said personal beauty information at a location remote from the beauty facility.

Maloney does not explicitly teach that said computer-readable media is a transportable computer-readable media.

However, it is old and well known that computer-readable media can be a transportable. For example, Maloney teaches floppy diskettes, compact discs and laser discs as a computer-readable medium (page 13, lines 31-32).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Maloney to include that said personal beauty information is recorded on a *transportable* media, because it would advantageously allow to use this method in geographical locations where network communication is not available.

Claim 44. Maloney teaches: recording, at beauty facilities (a central location or kiosks), personal beauty information of a subject, including an image of the subject (page 11, line 17-18; page 26, claim 20); wherein said recording and displaying obviously indicates recording said information on a computer-readable media. Furthermore, Maloney teaches that said recorded information can be accessed by the subject from home (remotely from the beauty facilities) (page 11, lines 13-14; page 6,

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lines 30-33); wherein providing the subject with image capturing device at home obviously indicates updating said personal beauty information at a location remote from the beauty facility. Furthermore, Maloney teaches allowing the subject to compare original and updated personal beauty information (page 20, lines 27-34).

Maloney does not explicitly teach that said computer-readable media is a transportable computer-readable media.

However, it is old and well known that computer-readable media can be a transportable. For example, Maloney teaches floppy diskettes, compact discs and laser discs as a computer-readable medium (page 13, lines 31-32).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Maloney to include that said personal beauty information is recorded on a *transportable* media, because it would advantageously allow to use this method in geographical locations where network communication is not available.

Dependent Claims

Claim 40. Providing the subject with image capturing device at home indicates updating step at a remote location (See reasoning applied to **claim 39**).

Claims 41-43. See reasoning applied to **claim 39**.

Claim 58. Maloney teaches: providing by the consumer personal beauty information (page 7, lines 1-2); wherein said information is provided on a transportable medium (a floppy diskette or compact disc, a handwritten questionnaire (page 13, line 31; page 6, line 32) or a digital camera (page 26, claim 20).

Claim 59. Maloney teaches: enabling a beauty facility (a central location or a kiosk) to record on transportable medium personal beauty information relating to beauty habits (page 6, line 32; page 7, lines 1-2; page 11, line 17; page 15, line 5; page 17, line 33).

Response to Arguments

Applicant's arguments filed 7/11/2006 have been fully considered but they are not persuasive.

In response to applicant's argument that the specification provide explanation of the terms "facilitating", "enabling", "encouraging", "prescribing", "associating", "instructing" and "causing", and, therefore, claim rejections under 35USC112 (2) has to be removed, it is noted that said explanation in specification, which the applicant relies on, is vague and indefinite. For example, paragraph [089] on page 32 of the specification gives following vague and mutually exclusive definitions of said terms:

"enabling", "facilitating", and "causing" an action refer to one or more of a direct act of performing the action, and any indirect act of encouraging or being an accessory to the action. Thus, the terms include partnering or cooperating with an entity who performs the action and/or referring commerce to or having commerce referred from an entity who performs the action. Other examples of indirect activity encompassed within the definitions of "enabling" "facilitating" and "causing" may include providing a subject with one or more of tools to knowingly aid in performing the action, providing instructions on how to perform the action, providing prompts or cues to perform the action, or expressly encouraging performance of the action. Indirect activity may also include cooperating with an entity who either directly performs the action or who helps another perform the action. Tools may include software, hardware, or access (either directly, through hyperlink, or some other type of cooperation or partnering) to a network location (e.g., web site) providing tools to aid in performing the action. Thus, phrases such as "enabling access" and "enabling display" do not necessarily require that the actor actually access or display anything."

As it can be seen, the specification explains that the step of "enabling display" does not require displaying anything. As such, "facilitating storage of information" does not require actual "storing" step. Accordingly, Examiner maintains that said terms are not clear and indefinite.

In response to applicant's argument that Claim Rejections under 35 USC § 101 has to be removed, it is noted that the recited method steps do not provide tangible, useful and concrete results. The method steps recited in the Claims are expressed in the following terms: "facilitating", "enabling", "encouraging", "prescribing", "associating", "instructing" and "causing", which are vague and indefinite. For example, in Claim 1, the step of "facilitating storage of information" does not require an actual "storing" step; the method step "enabling display" or "enabling the subject to view the first information" does not require displaying anything and, therefore, does not provide *tangible* result. In Claim 31, the step of "prescribing a cosmetic product" and "providing the subject with viewing access to the subject record" does not indicate real world application, therefore does not provide *tangible* result. In Claim 32, the method steps of "instructing the beauty facility to capture images" and "instructing the beauty facility to display ...images" does not recite an actual "capturing" or "displaying" steps, therefore, does not provide neither *useful*, no *tangible* result. And so as "facilitating storage of information" does not require the "storing" step per se, the recited method steps as a whole do not provide the repeatable result either.

Accordingly, the claimed invention does not appear to provide tangible and/or useful and/or concrete result and, therefore, deemed to be non-statutory.

Claim 31. In response to applicant's argument that Hawkins fails to disclose "establishing a subject record, the record including the first image," "associating the at least one second image with the subject record," and "providing the subject with viewing access to the subject record," it is noted that Hawkins explicitly teaches said features. Specifically, Hawkins teaches: selecting (prescribing) a cosmetic product for trial on the consumer's body [0038]; capturing an image of a body feature (*establishing a subject record*) [0039]; capturing a further image of the body feature at a later time after a cosmetic product has been applied by the consumer (*associating the at least one second image with the subject record*) [0041], wherein said capturing occurs at a sales counter (*beauty facility*) [0053]; digitally transforming the captured images to

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demonstrate effects of use of the cosmetic product (*associating the at least one second image with the subject record; wherein the use of a computer inherently indicates storing of the transformed information*) [0044]; displaying captured and transformed images to the user [0044].

Claims 32-38 and 57. In response to applicant's argument that Hawkins fails to disclose "distributing at least one cosmetic product to the beauty facility," "instructing the beauty facility to capture images of the external body condition before and after application of the at least one cosmetic product," and "instructing the beauty facility to display to the customer the before and after images so that the customer may be provided with a visual indication of progress," it is noted that Hawkins teaches: selecting a cosmetic product and capturing an image of a body feature before and after application of the cosmetic product at a sales counter (beauty facility) [0039]; [0053]; and displaying captured and transformed images to the user [0044]. Selecting the cosmetic product at the sales counter (*beauty facility*) inherently indicates *distributing* said cosmetic product to the point of sale. Examiner points out that without distributing said cosmetic product to said sales counter prior to offering said cosmetic product to the subject, it would not be possible to select and apply said product to the subject at said sales counter. Therefore, the step of "*distributing* said cosmetic product to the point of sale" is inherently disclosed in Hawkins. Furthermore, Hawkins teaches that the subject is assisted with said method at said sales counter by an operator [0053]. Examiner stipulates that without instructing said operator how to conduct said method prior to said "assisting" the subject, said operator would not be able to conduct said method. Therefore, the "instructing" steps are disclosed in Hawkins.

Claims 49, 60 and 61. In response to applicant's argument that Hawkins fails to disclose "analyzing the first and second information to determine an extent of differences that occurred in the body condition between the first and second time frames" and "prescribing at least one beauty product based on the extent of determined differences," it is noted that Hawkins explicitly teaches said features. Specifically,

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Hawkins teaches: selecting a cosmetic product for trial on the consumer's body (providing information) [0038]; capturing an image of a body feature [0039]; capturing a further image of the body feature at a later time [0041]; digitally transforming the captured images to determine differences that occurred in a body condition [0044]; offering (prescribing) a cosmetic product based on the results [0053].

Claims 1-4 and 53. In response to applicant's argument that Hawkins and Marapane fails to disclose "enabling the subject to view the first information, the second information, and at least part of the stored information," it is noted that Hawkins teaches capturing an image of a body feature [0039]; capturing a further image of the body feature at a later time after a cosmetic product has been applied by the consumer [0041]; digitally transforming the captured images to demonstrate effects of use of the cosmetic product [0044]; displaying captured and transformed images to the user [0044]. Marapane was applied to show storing information reflecting the subject's usage of the beauty product, including obtaining information regarding how often a subject has colored his/her hair over the past year (Figs. 1 and 16, item 130; page 4, lines 16-17).

In response to applicant's argument that there is no suggestion to combine Hawkins and Marapane, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case both references relate to recommending beauty products to customers based on information obtain from the customers. The motivation to combine the references would be to estimate subject's body (hair or skin) condition, and based on that provide a subject with another coloring, thereby provide the subject with most suitable product, as specifically stated in Marapane (page 4, lines 17-18).

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Claims 5-24, 27-30 and 54-56. In response to applicant's argument that Hawkins and Marapane fails to disclose "enabling the subject to view the first image, the second image, and the stored information on a display device, to thereby visually observe changes that occurred between times when the first and second images were captured," it is noted that Hawkins teaches: providing information about beauty products (selecting a cosmetic product for trial on the consumer's body) [0038]; capturing an image of a body feature [0039]; encouraging the subject to use at least one beauty product [0053]; capturing a further image of the body feature at a later time after a cosmetic product has been applied by the consumer [0041], wherein said capturing occurs at a sales counter (*beauty facility*) [0053]; digitally transforming the captured images to demonstrate effects of use of the cosmetic product (using a computer inherently indicates *storing of the transformed information*) [0044]; displaying captured and transformed images to the subject [0044]. Marapane was applied to demonstrate storing information reflecting the subject's usage of the beauty product, the usage occurring on at least one occasion between capture of the first image and capture of the second image (taking initial color reading of the subject hair; applying a beauty product to the subject's hair (coloring step); taking a second color reading of the subject hair after said coloring step) (page 8, lines 8-10).

Claims 48. In response to applicant's argument that Hawkins and Marapane fails to disclose "enabling the subject to view the first image, the second image, and the stored information on a display device, to thereby visually observe changes that occurred between times when the first and second images were captured," it is noted that Hawkins teaches: providing information about beauty products (selecting a cosmetic product for trial on the consumer's body) [0038]; capturing an image of a body feature [0039]; encouraging the subject to use at least one beauty product [0053]; capturing a further image of the body feature at a later time after a cosmetic product has been applied by the consumer [0041], wherein said capturing occurs at a sales counter (*beauty facility*) [0053]; digitally transforming the captured images to demonstrate effects of use of the cosmetic product (using a computer inherently indicates *storing of the transformed information*) [0044]; displaying captured and transformed images to the subject [0044]. Marapane was applied to disclose storing information reflecting the subject's usage of the beauty product, the usage occurring on at least one occasion between capture of the first image and capture of the second image (taking initial color reading of the subject hair; applying a beauty product to the subject's hair (coloring step); taking a second color reading of the subject hair after said coloring step) (page 8, lines 8-10).

Claims 50-52. In response to applicant's argument that Hawkins and Marapane fails to disclose "providing instructions for storage of third information relating to behavior of a subject between the first and second time frames," and "establishing a subject record, the record including the first, second and third information, wherein the subject is enabled to maintain control of the subject record," it is noted that Hawkins teaches: selecting a cosmetic product for trial on the consumer's body [0038]; capturing an image of a body feature [0039]; capturing a further image of the body feature at a later time [0041]; digitally transforming the captured images to determine differences that occurred in a body condition [0044]; offering a cosmetic product based on the results [0053]; wherein the method steps can be conducted at the subject's home over

the Internet [0053], thereby indicating: providing a computer-readable medium having instruction embedded therein for conducting said method; and enabling subject to control the saved data. Marapane was applied to disclose providing instructions for storing information reflecting subject's behavior between capture of the first image and capture of the second image (taking initial color reading of the subject hair; applying a beauty product to the subject hair (behavior step); taking a second color reading of the subject hair after said coloring step) (page 8, lines 8-10).

Claim 45. In response to applicant's argument that Maloney and Marapane fails to disclose "enabling the data structure to maintain a historical record of at least some of the recorded cosmetic product usage information and personal information," and "causing at least one product to be recommended to the individual, wherein the at least one product recommendation is generated using at least a portion of the historical record," it is noted that Maloney teaches: providing by the consumer information regarding preferred colors and styles, desired look of hair, desired look of face, level of involvement and lifestyle (page 7, lines 1-2); obtaining feedback from the consumer (*update*) for the cosmetic products offered (page 12, lines 15-16); based on the collected and updated information recommending a cosmetic product to the consumer (page 12, lines 15-16). Marapane was applied to show that said provided by the consumer information regarding preferred colors and styles, desired look of hair, desired look of face, level of involvement includes customer cosmetic product usage (obtaining information regarding how often a subject has colored his/her hair over the past year) (Figs. 1 and 16, item 130; page 4, lines 16-17).

Claims 46 and 47. In response to applicant's argument that Maloney and Marapane fails to disclose "causing, when the subject's cosmetic usage is inconsistent with the cosmetic usage of individual's with lifestyles similar to the subject's lifestyle, at least one product to be recommended to the subject," it is noted that Maloney teaches: providing by the consumer information regarding preferred colors and styles, desired look of hair, desired look of face, level of involvement and lifestyle (page 7, lines 1-2);

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obtaining feedback from the consumer (*update*) for the cosmetic products offered (page 12, lines 15-16); based on the collected and updated information recommending a cosmetic product to the consumer (page 12, lines 15-16). Marapane was applied to show that said provided by the consumer information regarding preferred colors and styles, desired look of hair, desired look of face, level of involvement includes customer cosmetic product usage (obtaining information regarding how often a subject has colored his/her hair over the past year) (Figs. 1 and 16, item 130; page 4, lines 16-17).

Claim 25. Applicant's arguments applied to claim 25 essentially the same as arguments applied to claim 5. Therefore, reasoning applied to claim 5 is equally applicable to claim 25.

Claims 39-43 and 58. In response to applicant's argument that Maloney fails to disclose "a transportable computer-readable media", it is noted that while Maloney teaches: providing a subject with a image capturing device for recording and displaying personal beauty information including an image of a subject (page 20, lines 27-28; page 26, claim 20); wherein said recording and displaying indicates recording said information on a computer-readable media, wherein said recorded information could be read at beauty facilities (a central location or kiosks) and updated (page 11, line 17-18; page 15, lines 4-6), and wherein providing the subject with image capturing device at home indicates updating said personal beauty information at a location remote from the beauty facility, Maloney does not explicitly teach that said computer-readable media is a transportable computer-readable media. However, Maloney teaches the use of floppy diskettes, compact discs and laser discs as a computer-readable medium (page 13, lines 31-32). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Maloney to include that said personal beauty information is recorded on a *transportable* media, because it would advantageously allow to use this method in geographical locations where network communication is not available.

Claims 44 and 59. Applicant's arguments applied to claims 44 and 59 essentially the same as those applied to claims 39-43 and 58. Therefore, reasoning applied to claims 39-43 and 58 is equally applicable to claims 44 and 59.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Igor Borissov whose telephone number is 571-272-6801. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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09/25/2006



IGOR N. BORISOV
PRIMARY EXAMINER